

REMARKS/ARGUMENTS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and it is respectfully submitted that the application as amended is patentable over the art of record. Reconsideration of the application as amended is respectfully requested.

Claims 1-8 remain in this application. Claim 9 has been added. Claim 1 has been amended for editorial reasons only.

Claims 1-2, and 5-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rahrer *et al.* (U.S. Patent No. 6,005,927) in view of Siitonen et al. (U.S. Patent No. 6,049,796). For the following reasons, the Examiner's rejection is respectfully traversed.

Claim 1, recites "a plurality of telephone directories including a plurality of user selectable directories for storing user selected phone numbers" wherein a "telephone number stored in the temporary storage memory is registered in at least one telephone directory memory associated with one of said user selectable directories selected from the plurality of telephone directories after making a call". The references do not teach these limitations of the claim.

The Examiner cites Siitonen as teaching a plurality of user selectable directories, pointing to Figs. 3, 4a, 5A, and col. 4 line 52 to col. 5, line 28. However, a close reading of the reference does not support the Examiner's assertion. Instead, Siitonen merely teaches a single directory (or database) with multiple fields that can include fax numbers, telephone numbers, name, company, email, address, etc. (see FIG. 3 and col. 2, lines 19-25 and 38-45). The figures cited by the Examiner merely show that the Siitonen device can be searched and/or sorted by any of these fields. There is no teaching of a plurality of user selectable directories, however. A single database with multiple fields is not the same. (In fact, the

invention also teaches multiple fields in a directory as in claim 2, for example, adding a name to the telephone number). Hence, claim 1 is patentable over the references. Claims 2 and 5-8, which depend, directly or indirectly, on claim 1, are patentable over the reference for at least the same reasons as claim 1.

Furthermore, claim 5 recites "an interface means for connection with an external memory device external to said terminal device". The Examiner states that Rahrer teaches an interface for connecting to a calling line identification receiver (CLID), and that such a device inherently has a memory, and thus teaches this limitation of the claim. However, the Examiner misreads the reference and improperly uses the concept of inherency.

The CLID is taught by Rahrer as being a part of the device (Fig. 1 is described as being a block diagram of the apparatus according to a first embodiment). Accordingly, the CLID is not an *external* device, as recited in the claim.

Furthermore, it is not enough to merely allege that a function or feature is "inherent". The Examiner must provide evidence and or rationale to show inherency. MPEP §2112. The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art) (emphasis added); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is *not* sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49

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USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112. The Examiner has failed to show that a memory must *necessarily be present* in the CLID, and thus cannot say that such a memory is inherent. In fact, it is quite possible that the CLID of the Rahrer device, if it needs a memory, could share that memory with the microprocessor, and thus provide its information directly to that memory in real time. Thus, it is not necessary that the CLID have a memory.

Accordingly, claim 5 is patentable over the references for either of these reasons as well.

In addition, claim 6 recites that "at least one of the telephone directory memories comprises the external memory device connected with a telephone terminal device main body via the interface means". The Examiner has failed to show that any telephone directory uses an external memory device (or even the CLID—which merely provides information from the telephone network, and is not a directory), and thus claim 6 is also patentable over the references for this reason as well.

Claims 3-4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rahrer *et al.* (U.S. Patent No. 6,005,927) in view of Marutiak (U.S. Patent No. 5,568,546). For the following reasons, the Examiner's rejection is respectfully traversed.

First, claims 3-4 depend, directly or indirectly, on one or more of the claims discussed above, and because Marutiak does not overcome the shortcomings of Rahrer or Siitonens, they are patentable over the combination for at least the same reasons as their parent claim(s).

Further, claims 3 & 4 recite that a directory or memory buffer telephone number, respectively, is “*automatically erased after passage of a predetermined time.*” The Examiner cited Marutiak, col. 6, lines 24-28, as teaching this element of the claims.

However, a close reading of the cited material does not support the Examiner’s assertion. Instead, Marutiak teaches that, if the abbreviated dialing list has not exceeded its maximum size, then no deletion is necessary (col. 6, lines 29-31). Thus, only when the memory gets full are the least frequently used numbers that have not been used for a given period of time deleted. If the memory is not full, there is no deletion.

In contrast, claims 4 and 5 are interpreted, from the literal claim language, that the number is erased after the passage of a certain time period, regardless of whether the memory is full or not. This means that the passage of time alone triggers the deletion. Thus, for example, one might say that the number is erased after a predetermined time of 24 hours. Then, after the passage of that time, the number is gone, whether or not the memory is full. Thus, the two features result in quite different results.

Consequently Marutiak does not teach the cited elements of claims 3 and 4, and thus they are patentable over the references.

Finally, as discussed in prior responses, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine the references to arrive at the claimed invention. Instead, the Examiner relies on the benefit of the secondary reference as motivation for making the modification to the primary reference. This, of course, is not proper, because that would then make any reference self-motivating, and that is clearly not the law. For example, the Examiner states that the motivation to use Siiitonens to modify Rahrer is because Siiitonens teaches “storing in the database one or more file records containing personal and business records containing names and calling numbers.” This is not

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motivation to modify Rahrer to add the Siitonan features. Instead, the examiner merely provides some benefits taught by Siitonan, and relies on that as motivation to modify Rahrer. That is legally insufficient to support a prima facie case of obviousness. Similar arguments are made for the other combinations. Accordingly, the rejections for obviousness should be withdrawn.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No.:16-0820; our Order No. 32739.

Respectfully submitted,

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